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NOTICE OF ALLOWANCE AND FEE(S) DUE

8791

7590

07/28/2008

BLAKELY SOKOLOFF TAYLOR & ZAFMAN LLP
1279 OAKMEAD PARKWAY
SUNNYVALE, CA 94085-4040

EXAMINER

ABEDIN, SHANTO

ART UNIT

PAPER NUMBER

2136

DATE MAILED: 07/28/2008

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/671,119	09/24/2003	Matthew B. Prince	006470.P001	7247

TITLE OF INVENTION: METHOD AND APPARATUS FOR A NON-REVEALING DO-NOT-CONTACT LIST SYSTEM

APPLN. TYPE	SMALL ENTITY	ISSUE FEE DUE	PUBLICATION FEE DUE	PREV. PAID ISSUE FEE	TOTAL FEE(S) DUE	DATE DUE
nonprovisional	NO	\$1440	\$300	\$0	\$1740	10/28/2008

THE APPLICATION IDENTIFIED ABOVE HAS BEEN EXAMINED AND IS ALLOWED FOR ISSUANCE AS A PATENT. PROSECUTION ON THE MERITS IS CLOSED. THIS NOTICE OF ALLOWANCE IS NOT A GRANT OF PATENT RIGHTS. THIS APPLICATION IS SUBJECT TO WITHDRAWAL FROM ISSUE AT THE INITIATIVE OF THE OFFICE OR UPON PETITION BY THE APPLICANT. SEE 37 CFR 1.313 AND MPEP 1308.

THE ISSUE FEE AND PUBLICATION FEE (IF REQUIRED) MUST BE PAID WITHIN THREE MONTHS FROM THE MAILING DATE OF THIS NOTICE OR THIS APPLICATION SHALL BE REGARDED AS ABANDONED. THIS STATUTORY PERIOD CANNOT BE EXTENDED. SEE 35 U.S.C. 151. THE ISSUE FEE DUE INDICATED ABOVE DOES NOT REFLECT A CREDIT FOR ANY PREVIOUSLY PAID ISSUE FEE IN THIS APPLICATION. IF AN ISSUE FEE HAS PREVIOUSLY BEEN PAID IN THIS APPLICATION (AS SHOWN ABOVE), THE RETURN OF PART B OF THIS FORM WILL BE CONSIDERED A REQUEST TO REAPPLY THE PREVIOUSLY PAID ISSUE FEE TOWARD THE ISSUE FEE NOW DUE.

HOW TO REPLY TO THIS NOTICE:

I. Review the SMALL ENTITY status shown above.

If the SMALL ENTITY is shown as YES, verify your current SMALL ENTITY status:

A. If the status is the same, pay the TOTAL FEE(S) DUE shown above.

B. If the status above is to be removed, check box 5b on Part B - Fee(s) Transmittal and pay the PUBLICATION FEE (if required) and twice the amount of the ISSUE FEE shown above, or

If the SMALL ENTITY is shown as NO:

A. Pay TOTAL FEE(S) DUE shown above, or

B. If applicant claimed SMALL ENTITY status before, or is now claiming SMALL ENTITY status, check box 5a on Part B - Fee(s) Transmittal and pay the PUBLICATION FEE (if required) and 1/2 the ISSUE FEE shown above.

II. PART B - FEE(S) TRANSMITTAL, or its equivalent, must be completed and returned to the United States Patent and Trademark Office (USPTO) with your ISSUE FEE and PUBLICATION FEE (if required). If you are charging the fee(s) to your deposit account, section "4b" of Part B - Fee(s) Transmittal should be completed and an extra copy of the form should be submitted. If an equivalent of Part B is filed, a request to reapply a previously paid issue fee must be clearly made, and delays in processing may occur due to the difficulty in recognizing the paper as an equivalent of Part B.

III. All communications regarding this application must give the application number. Please direct all communications prior to issuance to Mail Stop ISSUE FEE unless advised to the contrary.

IMPORTANT REMINDER: Utility patents issuing on applications filed on or after Dec. 12, 1980 may require payment of maintenance fees. It is patentee's responsibility to ensure timely payment of maintenance fees when due.

PART B - FEE(S) TRANSMITTAL

Complete and send this form, together with applicable fee(s), to: Mail **Mail Stop ISSUE FEE**
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INSTRUCTIONS: This form should be used for transmitting the ISSUE FEE and PUBLICATION FEE (if required). Blocks 1 through 5 should be completed where appropriate. All further correspondence including the Patent, advance orders and notification of maintenance fees will be mailed to the current correspondence address as indicated unless corrected below or directed otherwise in Block 1, by (a) specifying a new correspondence address; and/or (b) indicating a separate "FEE ADDRESS" for maintenance fee notifications.

CURRENT CORRESPONDENCE ADDRESS (Note: Use Block 1 for any change of address)

8791 7590 07/28/2008

BLAKELY SOKOLOFF TAYLOR & ZAFMAN LLP
1279 OAKMEAD PARKWAY
SUNNYVALE, CA 94085-4040

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Certificate of Mailing or Transmission

I hereby certify that this Fee(s) Transmittal is being deposited with the United States Postal Service with sufficient postage for first class mail in an envelope addressed to the Mail Stop ISSUE FEE address above, or being facsimile transmitted to the USPTO (571) 273-2885, on the date indicated below.

(Depositor's name)
(Signature)
(Date)

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/671,119 09/24/2003

Matthew B. Prince

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TITLE OF INVENTION: METHOD AND APPARATUS FOR A NON-REVEALING DO-NOT-CONTACT LIST SYSTEM

APPLN. TYPE	SMALL ENTITY	ISSUE FEE DUE	PUBLICATION FEE DUE	PREV. PAID ISSUE FEE	TOTAL FEE(S) DUE	DATE DUE
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nonprovisional

NO

\$1440

\$300

\$0

\$1740

10/28/2008

EXAMINER	ART UNIT	CLASS-SUBCLASS
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ABEDIN, SHANTO

2136

713-182000

1. Change of correspondence address or indication of "Fee Address" (37 CFR 1.363).

☐ Change of correspondence address (or Change of Correspondence Address form PTO/SB/122) attached.

☐ "Fee Address" indication (or "Fee Address" Indication form PTO/SB/47; Rev 03-02 or more recent) attached. Use of a **Customer Number is required.**

2. For printing on the patent front page, list

(1) the names of up to 3 registered patent attorneys or agents OR, alternatively,

1

(2) the name of a single firm (having as a member a registered attorney or agent) and the names of up to 2 registered patent attorneys or agents. If no name is listed, no name will be printed.

2

3

3. ASSIGNEE NAME AND RESIDENCE DATA TO BE PRINTED ON THE PATENT (print or type)

PLEASE NOTE: Unless an assignee is identified below, no assignee data will appear on the patent. If an assignee is identified below, the document has been filed for recordation as set forth in 37 CFR 3.11. Completion of this form is NOT a substitute for filing an assignment.

(A) NAME OF ASSIGNEE

(B) RESIDENCE: (CITY and STATE OR COUNTRY)

Please check the appropriate assignee category or categories (will not be printed on the patent): ☐ Individual ☐ Corporation or other private group entity ☐ Government

4a. The following fee(s) are submitted:

- ☐ Issue Fee
☐ Publication Fee (No small entity discount permitted)
☐ Advance Order - # of Copies _____

4b. Payment of Fee(s): (Please first reapply any previously paid issue fee shown above)

- ☐ A check is enclosed.
☐ Payment by credit card. Form PTO-2038 is attached.
☐ The Director is hereby authorized to charge the required fee(s), any deficiency, or credit any overpayment, to Deposit Account Number _____ (enclose an extra copy of this form).

5. Change in Entity Status (from status indicated above)

- ☐ a. Applicant claims SMALL ENTITY status. See 37 CFR 1.27. ☐ b. Applicant is no longer claiming SMALL ENTITY status. See 37 CFR 1.27(g)(2).

NOTE: The Issue Fee and Publication Fee (if required) will not be accepted from anyone other than the applicant; a registered attorney or agent; or the assignee or other party in interest as shown by the records of the United States Patent and Trademark Office.

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This collection of information is required by 37 CFR 1.311. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.14. This collection is estimated to take 12 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, Virginia 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Commissioner for Patents, P.O. Box 1450, Alexandria, Virginia 22313-1450.

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Determination of Patent Term Adjustment under 35 U.S.C. 154 (b) (application filed on or after May 29, 2000)

The Patent Term Adjustment to date is 833 day(s). If the issue fee is paid on the date that is three months after the mailing date of this notice and the patent issues on the Tuesday before the date that is 28 weeks (six and a half months) after the mailing date of this notice, the Patent Term Adjustment will be 833 day(s).

If a Continued Prosecution Application (CPA) was filed in the above-identified application, the filing date that determines Patent Term Adjustment is the filing date of the most recent CPA.

Applicant will be able to obtain more detailed information by accessing the Patent Application Information Retrieval (PAIR) WEB site (<http://pair.uspto.gov>).

Any questions regarding the Patent Term Extension or Adjustment determination should be directed to the Office of Patent Legal Administration at (571)-272-7702. Questions relating to issue and publication fee payments should be directed to the Customer Service Center of the Office of Patent Publication at 1-(888)-786-0101 or (571)-272-4200.

Notice of Allowability

Application No.

10/671,119

Examiner

SHANTO M Z ABEDIN

Applicant(s)

PRINCE, MATTHEW B.

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address--

All claims being allowable, PROSECUTION ON THE MERITS IS (OR REMAINS) CLOSED in this application. If not included herewith (or previously mailed), a Notice of Allowance (PTOL-85) or other appropriate communication will be mailed in due course. **THIS NOTICE OF ALLOWABILITY IS NOT A GRANT OF PATENT RIGHTS.** This application is subject to withdrawal from issue at the initiative of the Office or upon petition by the applicant. See 37 CFR 1.313 and MPEP 1308.

1. ☒ This communication is responsive to 06/30/2008.
2. ☒ The allowed claim(s) is/are 29,30,32-36,67-69 and 71-77.
3. ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 - a) ☐ All b) ☐ Some* c) ☐ None of the:
 1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

* Certified copies not received: _____.

Applicant has THREE MONTHS FROM THE "MAILING DATE" of this communication to file a reply complying with the requirements noted below. Failure to timely comply will result in ABANDONMENT of this application.
THIS THREE-MONTH PERIOD IS NOT EXTENDABLE.

4. ☐ A SUBSTITUTE OATH OR DECLARATION must be submitted. Note the attached EXAMINER'S AMENDMENT or NOTICE OF INFORMAL PATENT APPLICATION (PTO-152) which gives reason(s) why the oath or declaration is deficient.
 5. ☐ CORRECTED DRAWINGS (as "replacement sheets") must be submitted.
 - (a) ☐ including changes required by the Notice of Draftsperson's Patent Drawing Review (PTO-948) attached
1) ☐ hereto or 2) ☐ to Paper No./Mail Date _____.
 - (b) ☐ including changes required by the attached Examiner's Amendment / Comment or in the Office action of Paper No./Mail Date _____.
- Identifying indicia such as the application number (see 37 CFR 1.84(c)) should be written on the drawings in the front (not the back) of each sheet. Replacement sheet(s) should be labeled as such in the header according to 37 CFR 1.121(d).
6. ☐ DEPOSIT OF and/or INFORMATION about the deposit of BIOLOGICAL MATERIAL must be submitted. Note the attached Examiner's comment regarding REQUIREMENT FOR THE DEPOSIT OF BIOLOGICAL MATERIAL.

Attachment(s)

1. ☒ Notice of References Cited (PTO-892)
2. ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3. ☐ Information Disclosure Statements (PTO/SB/08),
Paper No./Mail Date _____
4. ☐ Examiner's Comment Regarding Requirement for Deposit of Biological Material
5. ☐ Notice of Informal Patent Application
6. ☐ Interview Summary (PTO-413),
Paper No./Mail Date _____
7. ☒ Examiner's Amendment/Comment
8. ☒ Examiner's Statement of Reasons for Allowance
9. ☐ Other _____.

DETAILED ACTION

1. This office action is in response to the communication filed on 06/30/2008.
2. The prior office actions are incorporated herein by reference. In particular, the observations with respect to claim language, and response to previously presented arguments.
3. Claims 29-36 and 67-82 are pending in the application.
4. Claims 31, 70 and 78-82 are cancelled by an examiner's amendments made in this office action.
5. Claims 29-30, 32-36, 67-69 and 71-77 are allowed.

RESPONSE TO ARGUMENTS

6. The applicant's arguments regarding 35 USC 103(a) type rejections are fully considered, and found persuasive, therefore, the previous 35 USC 103 (a) type rejections are withdrawn.
- 7.

EXAMINER'S AMENDMENT

8. An examiner's amendment to the record appears below. Should the changes and/or additions be unacceptable to the applicant, an amendment may be filed as provided by 37 CFR 1.312. To ensure consideration of such an amendment, it MUST be submitted no later than the payment of the issue fee. Authorization for this examiner's amendment was given in a telephone interview with the applicant's representative Mr. Daniel M. De Vos on July 17, 2008.

Claims 29-34, 67, 70-71 and 78-82 have been amended as follows:

Claim 29. (Currently Amended) A computer implemented method comprising:

a data collecting system collecting a set of one or more do-not-email list entries, each do-not-email list entry is a string of characters representing an email address;

applying ~~a one-way hashing~~ an encryption scheme to the set of one or more do-not-email list entries to ~~convert encrypt~~ the strings of characters ~~into unique hashed values~~ to create a set of one or more ~~hashed encrypted~~ do-not-email list entries, wherein the ~~one-way hashing encryption~~ scheme is intended to conceal the do-not-email list entries from an intended recipient;

transferring the set of one or more ~~hashed encrypted~~ do-not-email list entries to a master do-not-email list server configured to store the set of one or more ~~hashed encrypted~~ do-not-email list entries without revealing the email address corresponding to each of the ~~hashed encrypted~~ do-not-email list entries;

a client machine requesting from the master do-not-email list server at least one ~~hashed encrypted~~ do-not-email list entry from the set of one or more ~~hashed encrypted~~ do-not email list entries to create or update a client do-not-email list on ~~a~~ the client machine;

the client machine causing a client email list entry to be ~~hashed encrypted~~ using the same ~~one-way hashing encryption~~ scheme to create ~~a hashed an encrypted~~ client email list entry;

the client machine comparing the ~~hashed encrypted~~ client email list entry to the ~~hashed encrypted~~ do-not-email list entries on the client do-not-email list to determine whether the ~~hashed encrypted~~ client email list entry appears on the client do-not-email list; and

the client machine removing and/or not transmitting email to the email address that corresponds to the encrypted client email list entry upon determining that the encrypted client email list entry appears on the client do-not-email list; and

the client machine transmitting at least one email to the email address that corresponds to the hashed encrypted client email list entry upon determining that the hashed encrypted client email list entry does not appear on the client do-not-email list.

Claim 30. (Currently Amended) The method as in claim 29 wherein the hashed encrypted client email list entry is ~~a hashed~~ an encrypted value of an email address stored on the client machine.; ~~the client machine performs the causing of the client email entry to be hashed, the client machine performs the requesting from the master do-not-email list server, and the client machine performs the comparing the hashed client email entry to the client do-not-email list.~~

Claim 31. (Cancelled)

Claim 32. (Currently Amended) The method as in claim 29, further comprising configuring a master do-not-email list database to be in communication with the master do-not-email list server, the master do-not-email list database configured to store the set of one or more hashed encrypted do-not-email list entries for the master do-not-email list server.

Claim 33. (Currently Amended) The method as in claim 30 wherein the comparing of the hashed encrypted client list entry against the set of one or more hashed encrypted do-not-email list entries allows the client machine to protect the email address.

Claim 34. (Currently Amended) The method as in claim 29 wherein an email marketer maintains the client do-not-email list, the requesting from the master do-not-email list server of at least one

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~~hashed do not email list entry from the set of one or more hashed do not email list entries to create or update the client do not email list on the client machine is maintained by an email marketer.~~

Claim 67. (Currently Amended) A computer implemented method to identify email addresses registered on a do not contact list that are in a client's list without revealing the email addresses on the do not contact list or the client's list comprising:

the client encrypting at least certain of entries on the client's list to create a plurality of encrypted entries, where each entry includes at least an email address, wherein the entries are encrypted in a way that it is intended that an intended recipient cannot decrypt the entries;

the client transmitting over a network said plurality of encrypted entries from the client's list to a ~~service~~ master do not contact list server without revealing the email address corresponding to each of the encrypted entries for comparison to encrypted entries of the do not contact list, wherein the master do not contact list server is configured to store the encrypted entries of the do not contact list, wherein the encrypted entries of the do not contact list were formed by encrypting information, including at least an email address, ~~a matching of an encrypted entry from said plurality of encrypted entries from the client's list to an entry of the do not contact list represents that the underlying email address needs to be identified;~~

the client receiving results of the comparison, wherein the results of the comparison are an indication of which encrypted entries on the client's list match the encrypted entries on the do not contact list; ~~and the results are not unencrypted entries of the do not contact list; and~~ the client determining which entries on the client's list matched based on said received results;

the client removing the matched entries from the client's list and/or not transmitting email to the email addresses that correspond to the matched entries; and

the client transmitting at least an email to the email addresses in the client's list that correspond to the encrypted entries on the client's list that did not match the encrypted entries on the do not contact list.

Claim 70. (Cancelled)

Claim 71. (Currently Amended) A computer implemented method to identify email addresses registered on a do-not-contact list that are in a client's list without revealing the email addresses on the do-not-contact list or the client's list comprising:

the client encrypting at least certain of entries on the client's list to create a plurality of encrypted entries, where each entry includes at least an email address, wherein the entries are encrypted in a way that it is intended that an intended recipient cannot decrypt the entries;

the client transmitting over a network said plurality of encrypted entries from the client's list to a service master do not contact list server without revealing the email address corresponding to each of the encrypted entries for comparison to encrypted entries of the do-not-contact list, wherein the master do not contact list server is configured to store the encrypted entries of the do not contact list, wherein the encrypted entries of the do-not-contact list were formed by encrypting information, including at least an email address that belongs to a minor; ~~a matching of an encrypted entry from said plurality of encrypted entries from the client's list to an entry of the do not contact list represents that the underlying email address needs to be identified;~~

the client receiving results of the comparison, wherein the results of the comparison are an indication of which encrypted entries on the client's list match the encrypted entries on the do not contact list; ~~and the results are not unencrypted entries of the do not contact list;~~ and the client determining which entries on the client's list matched based on said received results;

the client removing the matched entries from the client's list and/or not transmitting email to the email addresses that correspond to the matched entries; and

the client transmitting at least an email to the email addresses in the client's list that correspond to the encrypted entries on the client's list that did not match the encrypted entries on the do not contact list.

Claim 78. (Cancelled)

Claim 79. (Cancelled)

Claim 80. (Cancelled)

Claim 81. (Cancelled)

Claim 82. (Cancelled)

EXAMINER'S REASONS FOR ALLOWANCE

9. The following is an examiner's statement of reasons for allowances:

Independent claim 29 is patentable over the cited prior arts because they do not anticipate nor fairly and reasonably teach transferring the set of one or more encrypted do-not-email list entries to a master do-not-email list server configured to store the set of one or more encrypted do-not-email list entries without revealing the email address corresponding to each of the encrypted

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do-not-email list entries; and a client machine requesting from the master do-not-email list server at least one encrypted do-not-email list entry from the set of one or more encrypted do-not email list entries to create or update a client do-not-email list on a the client machine; and the client machine comparing the encrypted client email list entry to the encrypted do-not-email list entries on the client do-not-email list to determine whether the encrypted client email list entry appears on the client do-not-email list; and the client machine removing and/or not transmitting email to the email address that corresponds to the encrypted client email list entry upon determining that the encrypted client email list entry appears on the client do-not-email list.

Independent claim 67 is patentable over the cited prior arts because they do not anticipate nor fairly and reasonably teach the client transmitting over a network said plurality of encrypted entries from the client's list to a master do not contact list server without revealing the email address corresponding to each of the encrypted entries for comparison to encrypted entries of the do not contact list, wherein the master do not contact list server is configured to store the encrypted entries of the do not contact list, wherein the encrypted entries of the do not contact list were formed by encrypting information, including at least an email address; and the client determining which entries on the client's list matched based on said received results; and the client removing the matched entries from the client's list and/or not transmitting email to the email addresses that correspond to the matched entries.

Independent claim 71 is patentable over the cited prior arts because they do not anticipate nor fairly and reasonably teach the client encrypting at least certain of entries on the client's list to create a plurality of encrypted entries, where each entry includes at least an email address, wherein

the entries are encrypted in a way that it is intended that an intended recipient cannot decrypt the entries; and the client transmitting over a network said plurality of encrypted entries from the client's list to a master do not contact list server without revealing the email address corresponding to each of the encrypted entries for comparison to encrypted entries of the do-not-contact list, wherein the master do not contact list server is configured to store the encrypted entries of the do not contact list, wherein the encrypted entries of the do-not-contact list were formed by encrypting information, including at least an email address that belongs to a minor; and the client receiving results of the comparison, wherein the results of the comparison are an indication of which encrypted entries on the client's list match the encrypted entries on the do not contact list; and the client removing the matched entries from the client's list and/or not transmitting email to the email addresses that correspond to the matched entries.

Dependent claims 30, 32-36, 68-69 and 72-77 are allowed because of their dependency on the allowable independent claims.

CONCLUSION

10. Claims 29-30, 32-36, 67-69 and 71-77 are patentable.
11. Any comments considered necessary by applicant must be submitted no later than the payment of the issue fee and, to avoid processing delays should be clearly labeled "Comments on Statement of Reasons for Allowance."
12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Shanto M Z Abedin whose telephone number is 571-272-3551. The examiner can normally be reached on M-F from 9:00 AM to 5:30 PM. If attempts to reach the

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examiner by telephone are unsuccessful, the examiner's supervisor, Moazzami Nasser, can be reached on 571-272-4195. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Shanto M Z Abedin

Examiner, A.U. 2136

/Nasser G Moazzami/

Supervisory Patent Examiner, Art Unit 2136